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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/035,172

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Charles E. Hunter

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EXAMINER

NGUYEN BA, HOANG VU A

ART UNIT

PAPER NUMBER

2421

MAIL DATE

DELIVERY MODE

08/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/035,172	Applicant(s) HUNTER ET AL.	
	Examiner Hoang-Vu A. Nguyen-Ba	Art Unit 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-28 and 33-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-28 and 33-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the amendment filed April 22, 2009.
2. Claims 19-28 and 33-47 are pending. Claims 19, 33, 38 and 43 are independent claims.

Response to Amendments

3. Per Applicants' request, Claims 19-21, 24-25 and 27-28 have been amended and new claims 33-47 have been added.

Response to Arguments

4. Applicant's arguments have been fully considered but are moot in view of the new grounds of rejection.

Claim Rejections – 35 USC § 103

5. The following is a quotation of the 35 U.S.C. § 103(a) which form the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 19-20, 24-27, 33-34, 36-39, 41-44 and 46-47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,177,931 to Alexander et al. ("Alexander") in view of U.S. Patent Application Publication No. 2002/0184047 by Plotnick et al. ("Plotnick").

It should be noted that hereinafter the use of the clause "see at least" should be interpreted that the cited portions that follow the clause are not the only portions that are considered to be relevant. Should Applicant find that the cited portions are not relevant, other portions of the disclosure of the prior art reference will be provided as additional evidence and/or context to the relevancy of the previously cited portions. Since the evidence is from the same reference, the introduction of the additional evidence in response to Applicant's arguments should not therefore be considered to be that of new grounds of rejection.

Claim 19

Alexander discloses *a method for displaying advertisements at a user location, comprising:*

displaying entertainment content at the user location, the entertainment content including insertion points for display of advertisements (see at least 6:56-59; 32:22-34:25);

receiving a plurality of advertisements at the user location (see at least 8:29-30; 8:41-43; 33:44-46; 34:11-12);

selecting a subset of the received advertisements based upon a customer preference (see at least 34:2-35:37; e.g., 34:10-12); and

displaying at least one of the selected advertisements during the first insertion point (see at least 22:20-23:11; 24:40).

Alexander does not specifically disclose the remaining features of the claim.

However, in an analogous art, Plotnick discloses at least:

determining, based on a subscription level of a user, that display of an advertisement is appropriate during a first insertion point (see at least [0047-0049]);

determining, based on the subscription level of the user, that display of an advertisement is not appropriate during a second insertion point (see at least [0047-0049]); and

continuing display of the entertainment content without displaying an advertisement during the second insertion point (see at least [0047-0049]).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Plotnick in Alexander because the use of Plotnick would give a user of Alexander several options according to his/her preference (e.g., the option of setting his/her receiver not to display VoD or PPV avails in the middle of a movie or the option of displaying these avails in the middle of a long movie so the user could take a short break, etc.; these options could subject to the billing option selected; it should be noted that the claimed second insertion

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point is interpreted as the middle of a show or movie rather the beginning or end which is equivalent to the first point of insertion), thereby improving the user's satisfaction.

Claim 20

The rejection of base claim is incorporated. Alexander-Plotnick further discloses

receiving a pre-recorded medium containing the entertainment content

(Alexander; see at least 33:44-46; 34:11-12) *and*

storing the medium at the user location (Alexander; see at least 33:44-46; 34:11-12).

Claim 24

The rejection of base claim 19 is incorporated. Alexander-Plotnick further discloses

caching the subset of received advertisements (Alexander; see at least 33:44-46; 34:11-12; caching in the RAM)

Claim 25

The rejections of the base claim 19 and intervening claim 24 are incorporated.

Alexander-Plotnick further discloses *selecting at least one of the cached advertisements based upon the customer preference* (Alexander; see at least 4:36-38; 22:1-18; 24:9-20; 27:49-28:9; 33:44-46; 34:11-12), *wherein the displaying at least one of the selected advertisements comprises displaying the selected cached advertisements* (Alexander; see at least 33:44-34:25; 22:1-18; 24:9-20; 27:49-28:9).

Claim 26

The rejection of base claim 19 is incorporated. Alexander-Plotnick further discloses

receiving the entertainment content from a source remote from the user location (Alexander; see at least 8:18-64).

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Claim 27

The rejection of base claim 19 is incorporated. Alexander-Plotnick further discloses *wherein: selecting a subset of the received advertisements based upon the customer preference comprises selecting a received advertisement based on the customer preference at a plurality of user locations in accordance with a purchase transaction by an advertiser* (Alexander; see at least 34:2-35:37).

Claim 33

Since Claim 33 recites a computer readable medium version of Claim 19, the same rejection set forth in Claim 19 is also deemed applicable to Claim 33.

Claim 34

Since Claim 34 recites a computer readable medium version of Claim 20, the same rejection set forth in Claim 20 is also deemed applicable to Claim 34.

Claim 36

Since Claim 36 recites a computer readable medium version of Claim 24, the same rejection set forth in Claim 24 is also deemed applicable to Claim 36.

Claim 37

Since Claim 37 recites a computer readable medium version of Claim 25, the same rejection set forth in Claim 25 is also deemed applicable to Claim 37.

Claim 38

Since Claim 38 recites a system version of Claim 19, the same rejection set forth in Claim 19 is also deemed applicable to Claim 38.

Claim 39

Since Claim 39 recites a system version of Claim 20, the same rejection set forth in Claim 20 is also deemed applicable to Claim 39.

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Claim 41

Since Claim 41 recites a computer readable medium version of Claim 24, the same rejection set forth in Claim 24 is also deemed applicable to Claim 41.

Claim 42

Since Claim 42 recites a system version of Claim 25, the same rejection set forth in Claim 25 is also deemed applicable to Claim 42.

Claim 43

Since Claim 43 recites a means-plus-function version of Claim 19, the same rejection set forth in Claim 19 is also deemed applicable to Claim 43.

Claim 44

Since Claim 44 recites a means-plus-function version of Claim 20, the same rejection set forth in Claim 20 is also deemed applicable to Claim 44.

Claim 46

Since Claim 46 recites a computer readable medium version of Claim 24, the same rejection set forth in Claim 24 is also deemed applicable to Claim 46.

Claim 47

Since Claim 47 recites a computer readable medium version of Claim 25, the same rejection set forth in Claim 25 is also deemed applicable to Claim 47.

7. Claims 21, 22, 35, 40 and 45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,177,931 to Alexander et al. ("Alexander") in view of U.S. Patent Application Publication No. 2002/0184047 by Plotnick et al. ("Plotnick").

It should be noted that hereinafter the use of the clause "see at least" should be interpreted that the cited portions that follow the clause are not the only portions that are considered to be relevant. Should Applicant find that the cited portions are not relevant, other portions of the disclosure of the prior art reference will be provided as additional evidence and/or context to the relevancy of the previously cited portions. Since the evidence is from the

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same reference, the introduction of the additional evidence in response to Applicant's arguments should not therefore be considered to be that of new grounds of rejection.

Claim 21

The rejections of the base claim 19 and intervening claim 20 are incorporated. Alexander-Plotnick does not specifically disclose *receiving entertainment content on a medium having a hardware security feature such that display of the entertainment content is possible only upon a player device including hardware compatible with the hardware security feature*.

However, official notice is taken that the feature claimed is well known in the art as circuit (e.g., V-chip) designed to selective blocking audio and video signals for the purpose of preventing the receiver to display of record video or movies containing violence or nudity (see U.S. Patent No. 5,828,402 or 4,554,584, or 5,387,942).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate this well known in the art circuit in Alexander-Plotnick for the purpose discussed above.

Claim 35

Since Claim 35 recites a computer readable medium version of Claim 21, the same rejection set forth in Claim 21 is also deemed applicable to Claim 35.

Claim 40

Since Claim 40 recites a system version of Claim 21, the same rejection set forth in Claim 21 is also deemed applicable to Claim 40.

Claim 45

Since Claim 45 recites a means-plus-function version of Claim 21 the same rejection set forth in Claim 21 is also deemed applicable to Claim 45.

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Claim 22

The rejections of the base claim 19 and intervening claims 20-21 are incorporated.

Alexander-Plotnick does not specifically disclose *wherein: the medium comprises a disk having a diameter greater than about 125 mm and less than 300 mm.*

However, official notice is taken that disc that has a diameter greater than 125 mm (i.e., 12.5 cm) and less than 300 mm (i.e., 30 cm) is the well-known laser disc that is defined as follows by Whatis.com (http://whatis.techtarget.com/definition/0,,sid9_gci212454,00.html):

laserdisc

Laserdisc is a technology and the physical medium used in storing and providing programmed access to a large database of text, pictures, and other objects, including motion video and full multimedia presentations.

The laserdisc itself is 12 inches in diameter and holds much more information than a CD-ROM disk can currently hold. Laserdiscs require relatively expensive players and are more expensive to distribute than CD-ROM disks. However, for school and corporate education purposes and any presentation requiring a great deal of motion video and the ability to create scripted or programmed access to selected portions of the laserdisc, the technology can be useful.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use disc which has a diameter (12 in or 28.48 cm) similar to that of a laser disc to store Alexander-Plotnick's broadcast and ads contents because such a disc would allow more information to be stored.

It is noted that Applicant's specification indicates that "discs **may** provide a hardware security feature by incorporating a larger diameter than conventional CD or DVD" (emphasis added by examiner). The use of "may" is interpreted that the use of disc size (e.g., larger than 12 cm) is optional and will not be considered a distinguishable feature over the prior art (i.e., 12 cm) because the feature is optional and is not described in details in the specification how large is the diameter of the disk (e.g., a specific size range) and which type of player can read this type of disc. Without further details of the disc size and which existing player on the market that can play the disc of the disclosed size, the feature is considered to be non-enabling.

8. Claim 23 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,177,931 by Alexander in view of U.S. Patent Application Publication No. 2002/0184047 by

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Plotnick et al. ("Plotnick") and further in view of High Density Digital Videodisc Using 635 nm Laser Diode by Tsuchiya et al. ("Tsuchiya").

Claim 23

The rejections of the base claim 19 and intervening claims 20-21 are incorporated.

Alexander-Plotnick does not specifically disclose *wherein: the medium comprises a disk having data recorded on a reflective layer and an optically transmissive coating having a total transmission at 635 nm of less than the minimum transmission set forth in the standard DVD specification.*

In an analogous art, Tsuchiya discloses a high density digital videodisc using 635 nm laser diode for the purpose of producing a high quality digital videodisc (see at least Abstract and Conclusions).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the teaching of Tsuchiya in combination with that of Alexander because the combination would allow more content to be stored on a high quality medium such as that taught in Tsuchiya.

Since the claim language is unclear as to which DVD Specification is being referred to and as to the meaning of "an optically transmissive coating having a total transmission at 635 nm of less than the minimum transmission set forth in the standard DVD specification," a coating that would reflect a 635 nm laser such as the one taught in Tsuchiya is used as a basis for the rejection of Claim 23 for compact prosecution purposes. Furthermore, since Applicant's disclosure does not specifically provide sufficient support for the claimed feature, Applicant is requested to provide the mentioned standard DVD specification and to point out where in the DVD specification is set forth the minimum transmission and how this feature is related to that of the 635 nm laser.

9. Claim 28 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,177,931 by Alexander in view of U.S. Patent Application Publication No. 2002/0184047 by

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Plotnick et al. ("Plotnick") and further in view of U.S. Patent No. 5,835,896 to Fisher et al. ("Fisher").

Claim 28

The rejection of base claim 19 is incorporated. Alexander-Plotnick further discloses *wherein: selecting a subset of the received advertisements based upon the customer preference comprises selecting a received advertisement based on the customer preference at a plurality of user locations* (Alexander; see at least 34:2-35:37).

Alexander-Plotnick does not specifically disclose that the selection is *in accordance with a winning bid of an advertiser in an auction*.

However, Fisher discloses a method for allowing a group of bidders to interactively place bids over a communications network, automatically recording the bids, updating the bidders with the current auction bid status information, closing the bidding process and notifying the winning bidder as to the auction outcome without using a human auctioneer (6:6-13).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Fisher in Alexander-Plotnick as the use of Fishers technique would help advertisers to place bids for their advertisements and to know the outcome of the auction quickly for effective planning purposes.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on

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the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu “Antony” Nguyen-Ba whose telephone number is (571) 272-3701. The examiner can normally be reached on Monday-Friday from 9:00 am to 5:30 pm.

If attempts to reach the examiner are unsuccessful, the examiner’s supervisor, John Miller can be reached at (571) 272-7353.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2400 Group receptionist (571) 272-2400.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Hoang-Vu Antony Nguyen-Ba/

Primary Examiner, Art Unit 2421

August 16, 2009